



17148

TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

Application Number

09/640,526

Filing Date

August 17, 2000

First Named Inventor

Nicolson, et al

Art Unit

1714

Examiner Name

Edward Cain

Attorney Docket Number

003707.00009

ENCLOSURES (check all that apply)

☒ Fee Transmittal Form

☐ Fee Attached

☐ Amendment / Reply

☐ After Final

☐ Affidavits/declaration(s)

☐ Extension of Time Request

☐ Express Abandonment Request

☒ Information Disclosure
Statement

☐ Certified Copy of Priority
Document(s)

☐ Reply to Missing Parts/
Incomplete Application

☐ Reply to Missing Parts
under 37 CFR 1.52 or 1.53

☐ Drawing(s)

☐ Licensing-related Papers

☐ Petition

☐ Petition to Convert to a
Provisional Application

☐ Power of Attorney, Revocation
Change of Correspondence
Address

☐ Terminal Disclaimer

☐ Request for Refund

☐ CD, Number of CD(s) _____

☐ Landscape Table on CD

☐ After Allowance Communication to TC

☐ Appeal Communication to Board
of Appeals and Interferences

☐ Appeal Communication to TC
(Appeal Notice, Brief, Reply Brief)

☐ Proprietary Information

☐ Status Letter

☒ Other Enclosure(s)
(please identify below):

IDS Form PTO/SB/08A&B
Copies of Cited References
Certificate of Express Mail
Return Receipt Postcard

Remarks

The Commissioner is hereby authorized to charge any deficiency in fees
or credit any overpayment of fees to our deposit account # 19-0733.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm

Banner & Witcoff, LTD.

Signature

Printed Name

Shawn Gorman

Date

December 14, 2004

Reg. No.

56,197

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

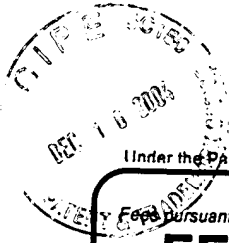
Signature

Typed or printed name

Date

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Effective on 12/08/2004.
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL

For FY 2005

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$)
180.00

Complete if Known

Application Number 09/640,526
Filing Date August 17, 2000
First Named Inventor Nicolson, et al
Examiner Name Edward Cain
Art Unit 1714
Attorney Docket No. 003707.00009

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify):
☒ Deposit Account Deposit Account Number 19-0733 Deposit Account Name Banner & Witcoff
For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee
☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

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FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent	50	25
Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent	200	100
Multiple dependent claims	360	180

Total Claims **Extra Claims** **Fee (\$)** **Fee Paid (\$)** **Multiple Dependent Claims**
- 20 or HP = _____ x _____ = _____
HP = highest number of total claims paid for, if greater than 20
Indep. Claims **Extra Claims** **Fee (\$)** **Fee Paid (\$)**
- 3 or HP = _____ x _____ = _____
HP = highest number of independent claims paid for, if greater than 3

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets **Extra Sheets** **Number of each additional 50 or fraction thereof** **Fee (\$)** **Fee Paid (\$)**
- 100 = _____ / 50 = _____ (round up to a whole number) x _____ = _____

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount) **Fees Paid (\$)**

Other: IDS

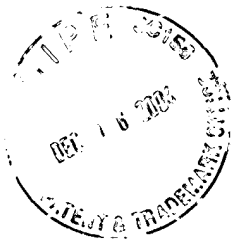
180.00

SUBMITTED BY

Signature Shawn Gorman Registration No. 56,197 Telephone 312-463-5000
Name (Print/Type) (Attorney/Agent) Date 12/14/04

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Attorney Docket No. 003707.00009)

In re U.S. Patent Application of :)	
Nicolson, et al.)	Examiner: Edward Cain
Application No. 09/640,526)	
)	Art Unit: 1714
Filed: August 17, 2000)	
)	Confirmation No. 6172
For: Extended Wear Ophthalmic Lens)	

INFORMATION DISCLOSURE STATEMENT

Mail Stop Amendment
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Pursuant to 37 C.F.R. Section 1.97-1.98, Applicants wish to make the following references listed on the enclosed Form PTO/SB/08A&B of record in the above-identified application. This Information Disclosure Statement is in compliance with the continuing duty of candor as set forth in 37 C.F.R. Section 1.56.

As this Information Disclosure Statement is being submitted after the issuance of an office action on the merits, the Commissioner is hereby authorized to charge any fee due or credit any overpayment of fee to Deposit Account No. 19-0733.


12/20/2004 AWONDAF1 00000133 190733 09640526
01 FC:1806 180.00 DA

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated: December 14, 2004

By:


Shawn Gorman
Reg. No. 56,197

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10 South Wacker Dr.
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(312) 463-5001 - fax

Substitute for form 1449A/PTO

INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(use as many sheets as necessary)

Sheet	1	of	2
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Complete if Known

Application Number	09/640,526
Filing Date	August 17, 2000
First Named Inventor	Nicolson, et al
Art Unit	1714
Examiner Name	Edward Cain
Attorney Docket Number	003707.00009

U.S. PATENT DOCUMENTS

[illegible]

FOREIGN PATENT DOCUMENTS

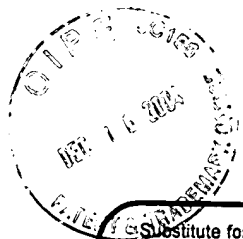
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**Examiner
Signature**

Date
Considered

<p>EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. 1 Applicant's unique citation designation number (optional). 2 See Kinds Codes of USPTO Patent Documents at www.uspto.gov/mpep 901.04. 3 Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). 4 For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. 5 Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. 6 Applicant is to place a check mark here if English language Translation is attached.</p>	<p>Considered</p>
<p>This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.</p>	

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PTO/SB/08b(05-03)

Approved for use through 04/30/2003. OMB 0651-0031

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**INFORMATION DISCLOSURE
STATEMENT BY APPLICANT**

(use as many sheets as necessary)

Sheet 2 of 2

Complete if Known

Application Number	09/640,526
Filing Date	August 17, 2000
First Named Inventor	Nicolson, et al
Group Art Unit	1714
Examiner Name	Edward Cain
Attorney Docket Number	003707.00009

OTHER PRIOR ART -- NON PATENT LITERATURE DOCUMENTS

Examiner Initials *	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
		HUNG, WILLIAM, Preparation and Testing Silicone Containing Hydrogel Lenses as Described in US Patent No. 52180000, submitted to EP patent office regarding EP Patent No. 0819258, April 1, 2004.	
		BREUER & MULLER, Grounds of Appeal, in EP Patent application 96 908 116.5-2217, dated April 1, 2004.	
		FISHER, ADRIAN JOHN, Submissions of Opponent II in response to the Proprietors' Appeal, dated August 24, 2004.	
		WINTERTON, LYNN C., et al., Coulometric Method for Measuring Oxygen Flux and Dk of Contact Lenses and Lens Materials, ICLC, vol. 14, No. 11, November 1987, pp. 441-450.	
		Declaration of William J. Benjamin, Professor of Optometry and Physiological Optic University of Alabama at Birmingham, August 24, 2004.	
		Package Insert, Focus Night & Day Soft Contact Lenses for Extended Wear, print date: September 2001.	
		Order of J. Merkel in Federal Court of Australia, Victoria District Registry, Novartis AG v. Bausch & Lomb (Australia) Pty, Ltd [2004] FCA 835, dated August 24, 2004.	
		Criticism of the Experimental Report provided by Dr. William M. Hung,, submitted to EP patent office regarding EP Patent No. 0819258, August 24, 2004.	
		HEIDELBERG, ALFRED HUTHIG VERLAG; Praktikum Der Makromolekularen Organischen Chemie, 1996. (Translation of relevant section included)	
		EP Patent application No. 90810308.8; Answer to EPO concerning Office Action, dated March 30, 1994. (Translation of relevant section included)	

Examiner Signature		Date Considered	
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*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

1 Applicant's unique citation designation number (optional). 2 Applicant is to place a check mark here if English language Translation is attached. This collection of information is required by 37 CFR 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 120 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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